



Paper No. 17

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**OCT 22 2003**

**OFFICE OF PETITIONS**

In re Application of  
Kilvert  
Application No. 09/646,261  
Filed: September 11, 2000  
Attorney Docket No. 7372-2

ON PETITION

This decision concerns the October 14, 2003 "Renewed Petition for Revival" which, in fact, is a petition under 37 CFR 1.137(a) to revive the above-referenced application.

The petition is **DISMISSED**.

On December 19, 2001, a non-final Office action was mailed, setting forth a 3-month shortened statutory reply period.

On June 24, 2002 (Certificate of Mailing date June 19, 2002), Applicant filed, *inter alia*, an amendment along with a request for a 3-month extension of time and the requisite extension-of-time fee.

On August 23, 2002, a "Response to Amendment" was mailed by the Examiner, stating that the June 24, 2002 amendment, while non-responsive to the December 19, 2001 non-final Office Action, appeared to be a *bona fide* reply. A 1-month shortened statutory reply period was provided. No response was filed. The application became abandoned on September 24, 2002.

The instant petition requests revival of the application under the "unavoidable" delay standard of 37 CFR 1.137(a).

A grantable petition under 37 CFR 1.137(a), in the instant case, must include:

- (1) the required reply;<sup>1</sup>

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<sup>1</sup> The "required reply" to a non-final Office action may be: an argument or an amendment fully responsive to the Office action in question; the filing of a continuing application under 37 CFR 1.53(b); or the filing of a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if the utility application was filed on or after 6/8/95. MPEP 711.03(c)(III)(A) (Rev. 1, Feb. 2003).

- (2) the \$55 petition fee (small entity);
- (3) a **showing** to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date until the filing of a grantable §1.137(a) petition was unavoidable.<sup>2</sup>

Regarding item (2), the petition authorizes the USPTO to charge the petition fee to Deposit Account No. 23-3030.

The petition lacks item (1) and, as discussed below, item (3).

In prosecuting a patent application, the applicant is required to exercise diligence generally observed by prudent men in relation to their most important business.<sup>3</sup> An application becomes abandoned if the applicant fails to timely respond to an outstanding Office action.<sup>4</sup> To request revival of an application so abandoned, the applicant must show due diligence in prosecuting the application.<sup>5</sup> The applicant also has the burden to show, to the satisfaction of the Commissioner, that the entire delay, including the delay that caused the abandonment and the delay in filing a grantable petition to revive, was “unavoidable” despite the applicant’s exercise of due diligence.<sup>6</sup>

The petition asserts that the August 23, 2002 correspondence appears to have been received in counsel’s docketing department, as evidenced by the September 23, 2002 docket date for the instant application. The basis for requesting revival under 37 CFR 1.137(a) is that counsel “was unaware of the August 23, 2002 letter.”

However, the petition fails to **show** that there is in place, in counsel’s firm, a business routine for docketing USPTO Office actions, and, if so, what the business routine entails; that the docketing clerks are sufficiently trained and experienced for duties within the docketing department; and that counsel’s “unawareness” of the August 23, 2002 Response to Amendment was the result of

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<sup>2</sup> An intentional delay in seeking the revival of an abandoned application precludes a finding of unavoidable delay under 37 CFR 1.137(a). See MPEP section 711.03(c)(III)(D) (Rev. 1, Feb. 2003); 35 U.S.C. 133; Douglas v. Manbeck, 21 U.S.P.Q.2d 1697; 1991 U.S. Dist. LEXIS 16404, 16412-13 (E.D. Pa. 1991); In re Takao, 1990 Dec. Comm’r Pat. 6, 10 (Comm’r Pat. 1990), 7 U.S.P.Q.2d 1155, citing Ex Parte Naef, 1905 Dec. Comm’r Pat. 121 (Comm’r Pat. 1905).

<sup>3</sup> Haines v. Quigg, 673 F.Supp. 314, 317; 5 U.S.P.Q.2d 1130 (N.D. Id. 1987), citing Ex Parte Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (Comm’r Pat. 1887); In re Mattullath, 38 App. D.C. 497, 510-511; 1912 U.S. App. LEXIS 2157, 2177-78 (D.C. Cir. 1912); Winkler v. Ladd, 221 F.Supp 550, 553; 138 U.S.P.Q. 666 (D.D.C. 1963).

<sup>4</sup> 37 CFR 1.135.

<sup>5</sup> See Douglas v. Manbeck, *supra* note 2, at 16414, citing Futures Technology, Ltd. v. Quigg, 684 F. Supp. 430, 431; 7 U.S.P.Q.2d 1588 (E.D. Va. 1988); Takao, *supra* note 2, at 13-14.

<sup>6</sup> Haines v. Quigg, *supra* note 3, at 316.

a rare mistake made by a properly trained and reliable employee, and an isolated incidence.<sup>7</sup>

In sum, the petition fails to show that the entire delay in submitting the required reply is “unavoidable” within the meaning of §1.137(a).<sup>8</sup>

In view of the above, the petition is dismissed.

### Options

(I) A renewed §1.137(a) petition may be filed to revive the application (no fee). To be grantable, such a renewed petition must:

- be filed within **TWO MONTHS** of the mailing date of this decision;<sup>9</sup>

- include:

- a proper reply to the August 23, 2002 Response to Amendment (courtesy copy attached);<sup>10</sup>

- a **sufficient showing** that the **entire** delay in filing the required reply was “unavoidable”;

and should be addressed as follows:

- by mail/by hand: Commissioner for Patents, USPTO  
Attn: Office of Petitions  
Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

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<sup>7</sup> See MPEP section 711.03(c)(III)(C)(2) (Rev. 1, Feb. 2003), citing *In re Egbers*, 6 U.S.P.Q.2d 1869, 1872 (Comm’r Pat. 1988), rev’d on other grounds *sub nom*; *Theodor Groz et al. V. Quigg*, 10 U.S.P.Q.2d 1787 (D.D.C. 1988); *In re Katrapat*, 6 U.S.P.Q.2d 1863, 1867-68 (Comm’r Pat. 1988) (A delay resulting from . . . a docketing error . . . on the part of an employee in the performance of a clerical function may provide the basis for a showing of “unavoidable” delay, provided it is shown that: . . . there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; . . . the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.).

<sup>8</sup> MPEP section 711.03(c)(III)(C)(2) (Rev. 1, Feb. 2003), citing *Haines v. Quigg*, *supra* note 3, at 317; *Vincent v. Mossinghoff*, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 U.S.P.Q. 1091, 1981 U.S. Dist. LEXIS 13616, 13620 (D.D.C. 1981); *Potter v. Dann*, 201 U.S.P.Q. 574, 1978 U.S. Dist. LEXIS 17391, 17393 (D.D.C. 1978).

<sup>9</sup> 37 CFR 1.137(e)(1); extensions of time under 37 CFR 1.136(a) are available.

<sup>10</sup> See *supra* note 1.

-by fax:<sup>11</sup>

(703) 308-6916  
Attn: Office of Petitions

- (II) Applicant may revive the application based on unintentional abandonment under 37 CFR 1.137(b).<sup>12</sup> For the instant application, such a petition requires a \$665 petition fee (small entity),<sup>13</sup> and a **statement** that the **entire** delay in submitting the required reply to the August 23, 2002 Response to Amendment from the due date until the filing of a grantable §1.137(b) petition was unintentional.<sup>14</sup>

While a §1.137(b) petition is not subject to the 2-month limitation, intentionally delaying the filing of such a petition defeats the purpose of this provision, and will result in dismissal of the petition.

A §1.137(b) petition, should one be desired, should also be addressed as instructed above.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.



RC Tang  
Petitions Attorney  
Office of Petitions

Attachment:

8/23/02 Response to Amendment (courtesy copy)

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<sup>11</sup> This facsimile number may not be used for filing petitions after 12/1/03.

<sup>12</sup> Such petitions are evaluated under the less stringent "unintentional delay" standard. MPEP section 711.03(c)(III)(C) (Rev. 1, Feb. 2003). The dismissal or denial of a §1.137(a) petition does not preclude an applicant from obtaining relief under §1.137(b) unless the decision dismissing or denying the §1.137(a) petition states otherwise. MPEP section 711.03(c)(III)(C)(2) (Rev. 1, Feb. 2003).

<sup>13</sup> A fee is required because a §1.137(b) petition is not a renewed §1.137(a) petition.

<sup>14</sup> See 37 CFR 1.137(b)(3).